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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/755,541	01/05/2001	Anthony R. Rothschild	733755-6	5271
23879	7590	08/10/2009		
O'Melveny & Myers LLP IP&T Calendar Department LA-13-A7 400 South Hope Street Los Angeles, CA 90071-2899			EXAMINER	
			CARLSON, JEFFREY D	
			ART UNIT	PAPER NUMBER
			3622	
			MAIL DATE	DELIVERY MODE
			08/10/2009	PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 09/755,541	<b>Applicant(s)</b> ROTHSCHILD, ANTHONY R.
	<b>Examiner</b> Jeffrey D. Carlson	<b>Art Unit</b> 3622

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If no period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).

Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(o).

#### Status

1) Responsive to communication(s) filed on 21 May 2009.

2a) This action is **FINAL**.      2b) This action is non-final.

3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

4) Claim(s) 62,65,68-70,73,75-77,81,84,86-90 and 92-95 is/are pending in the application.

4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

5) Claim(s) \_\_\_\_\_ is/are allowed.

6) Claim(s) 62,65,68-70,73,75-77,81,84,86-90 and 92-95 is/are rejected.

7) Claim(s) \_\_\_\_\_ is/are objected to.

8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

9) The specification is objected to by the Examiner.

10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) All    b) Some \* c) None of:

1. Certified copies of the priority documents have been received.
2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

1) Notice of References Cited (PTO-892)

2) Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date 1/26/09

4) Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_

5) Notice of Informal Patent Application

6) Other: \_\_\_\_\_

**DETAILED ACTION**

1. This action is responsive to the paper(s) filed 5/21/2009.

***Claim Rejections - 35 USC § 103***

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. **Claims 62, 65, 68-70, 73, 75-77, 81, 84, 86-90 and 92-95 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gabbard et al (US6205432) as above and further in view of Roth et al (US6285987).**

4. Regarding claims 62, 65, 68, 75, 81, 87, 89, 90, 92, 94, 95,
5. Gabbard et al teaches a system whereby advertising is selectively inserted into (Internet, i.e. WAN) emails sent by senders to recipients [abstract]. Gabbard et al teaches that the emails may be sent using "web mail" and that the ads are inserted before being delivered to the identified recipients [col 2: lines 19-23, 4:33, 10:8]. This arrangement of web mail is taken to provide the web server including an advertising application that permits communication data to be submitted that includes the message and the recipient email address. Gabbard et al teaches that the ads may be automatically selected and inserted according to user demographics [abstract] which provides a teaching that there are a plurality of stored ads to choose from. Gabbard et al teaches that an implementation of the invention may include a web-based "free" email

service [10:8] which is taken to provide compensation to the users of the free email service, whether they be senders benefiting from the advertising subsidization or receivers benefiting from the advertising subsidization, especially where both sender and receiver have registered as part of the free web-based email service. Gabbard et al teaches advertising to be targeted (selected) according to user demographics or commitments to advertisers. Gabbard et al contemplates that "other criteria can be used without departing from the spirit of the invention" in order to accomplish the targeted advertising [10:20-23], but Gabbard et al fails to explicitly teach targeting advertising according to the subject matter or content of the email message/body itself. Roth et al also teaches advertising that is automatically inserted according to advertisers targeting criteria when an advertising opportunity (view-op) presents itself. While Roth et al teaches advertising to appear on web pages, he nonetheless teaches that the ad chosen to be shown on that webpage/screen can be targeted according to several factors including both the demographics of the user and the keywords of the content being read by that user [abstract, 2:14-17, 10:62, 14:24-25]. Given the motivation provided by Gabbard et al to seek other known advertising targeting criteria, it would have been obvious to one of ordinary skill at the time of the invention to have also used the keywords (i.e. subject matter, content) in Gabbard et al's email messages so that the advertising can be more relevant to the current view-op, thus providing more effective advertising. It is further noted that Gabbard et al's emails can be represented by web pages where the emails are provided as part of a "web mail" application.

6. Regarding claims 69, 76, 77, Gabbard et al teaches that an implementation of the invention may include a web-based "free" email service [10:8] which is taken to provide compensation to the users of the free email service, whether they be senders benefiting from the advertising subsidization or receivers benefiting from the advertising subsidization, especially where both sender and receiver have registered as part of the free web-based email service.

7. Regarding claims 70, 73, Gabbard et al does not explicitly state that the advertisement can be clicked, however Official Notice is taken that Internet ads are well known to include a link to further information about the advertised product and it would have been obvious to one of ordinary skill at the time of the invention to have enabled the ability for an interested user to request and receive more information about an advertised product. It would have been obvious to one of ordinary skill at the time of the invention to have hosted the ad content and/or the additional ad content on any server that can be accessed via the Internet as a mere design choice. Doing so provides a step receiving the additional ad data at the particular server before sending it to the requesting user.

8. Regarding claims 84, 86, inserting an advertisement into the emails of Gabbard et al is taken to inherently provide creating a copy or "instance" of the advertising object from the ad server into the email itself.

9. Regarding claims 88, 93, the sender of Gabbard et al is able to specify his recipient and the message content. Gabbard et al's selection of particular ads targeted to the recipient and the obviousness of targeting to content can be taken to provide the

feature of allowing the sender to specify ad-type data that is used to select the advertisement. Further, providing the user profile data (such as demographic information) by the user to the system is taken to address the limitation of providing advertisement-type data, as this profile information is the basis for the type of ad selected according to that user-provided information.

***Response to Arguments***

10. Applicant argues that Roth et al fails to teach ad selection based on content because ads are selected according to a highest bidder. A view-op triggers an ad selection process. The ad selection process includes collecting bids where there is a match in keyword/content. The selection process also includes steps of not bidding where keywords are not matched. Content therefore is used in ad selection.

11. Applicant argues that the keywords of Roth et al are collected beforehand (stored in database tables) and therefore his methods cannot translate to emails which are written and then (more or less) immediately sent. Examiner disagrees. First, it is noted that Gabbard et al's emails can be represented by web pages where the emails are provided as part of a "web mail" application. Further, Roth et al determines webpage keywords when the view-op is created (i.e. when the web page is requested by a web browser). Roth et al's noted database tables 16B include 4 tables (HUD, SOD, CUD, AAD) none of which include any indication of webpage keywords [cols 9:49-10:30]. The 5<sup>th</sup> table (VOD) is a *temporary* data table which is populated at the time of the view-op [10:31-37] and sent to the ad selection process (bidding agents) and is populated with

freshly-retrieved data such as the user's browser type making the HTTP request [10:51], the user's IP address [10:45] and the "keywords which *appear* on the site" [10:62]. Nowhere in Roth et al is it stated that web sites are spidered ahead-of-time and keywords for the sites are stored in a database. Therefore arguments that emails cannot be collected beforehand are moot.

12. Applicant argues that Roth et al fails to teach how email information would be collected. Indeed Roth et al doesn't so we turn to one of ordinary skill who was tasked with considering additional targeting techniques. One of ordinary skill would find it obvious to analyze the emails of Gabbard et al's in an attempt to determine their content so that better targeted advertising could take place. Applicant notes that sometimes web pages include meta tags which can be used to assist in the determination of the page's content. While this is true, Roth et al does not necessarily use this technique. In fact, Roth et al does not appear to explicitly state examples of how (at the time of the view-op) he determines keywords for a page. He assumes that one of ordinary skill would be able to accomplish such a determination at the time of view-op; examiner believes one of ordinary would indeed understand that a parsing technique to locate frequently occurring words would be one example. Applicant's claims do not require any particular technique for determining content. Nor does applicant's disclosure provide any inkling to a reader how to accomplish determination of content (applicant is invited to indicate where such a teaching may have been missed by the examiner). It is noted that the examiner has not determined this feature of applicant to be non-enabled. For the same reasons that no 112 ¶ 1 rejection was made, it is assumed to be within

routine skill to determine keywords/content of Roth et al. Applicant's arguments that question how Roth et al would select an ad for an email message stating "my boss has me jumping through hoops" are moot when applicant's claims and disclosure fail to offer a solution.

13. Applicant argues that web pages are public and emails are private and further that there are privacy/legal limitations to who can access emails. Bear in mind that this rejection is based on the base reference of Gabbard et al who presumably already has authority to access user's emails *in view of* a modification based on Roth et al that would have been obvious to one of ordinary skill.

#### ***Conclusion***

14. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jeffrey D. Carlson whose telephone number is 571-272-6716. The examiner can normally be reached on Monday-Fridays; off alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eric Stamber can be reached on (571)272-6724. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Jeffrey D. Carlson/  
Primary Examiner, Art Unit 3622

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